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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,980	02/09/2004	Elizabeth M. Doherty	A-824	1288

7590 06/06/2006

U.S. Patent Operations/RVP
Dept. 4300, M/S 27-4-A
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EXAMINER

CHANG, CELIA C

ART UNIT PAPER NUMBER

1625

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/775,980	Applicant(s) DOHERTY ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-10 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-10, 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment and response filed by applicants dated Mar. 23, 2006 have been entered and considered carefully. Claims 2-5, 7, 11-13 have been canceled. Claims 1, 6-10, 14-20 are pending.

The modification of the restriction requirement suggested by applicants is acceptable with the following clarification:

- Group I : Q1-Q4, X1 and X3 are each carbon, a further election of a single disclosed species is also required and further restriction based on the elected species may also be required.
- Group II: one or more of Q1-Q4 is nitrogen, X2 and X3 are carbon, a further election of a single disclosed species is also required and further restriction based on the elected species may also be required.
- Group III: Q1-Q4 are each carbon, and one or two of X2 and X3 are nitrogen, a further election of a single disclosed species is also required and further restriction based on the elected species may also be required.
- Group IV: one or more of Q1-Q4 is nitrogen, one or two of X2 and X3 are nitrogen, a further election of a single disclosed species is also required and further restriction based on the elected species may also be required.

Applicant's election of Group I, species of example 71 in the reply filed on Mar. 23, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1, 6-10, 14-20 being drawn to group I are prosecuted.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1, 6, 9, 14, 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Das et al. US 6,596,746 or Hynes et al. US 2004/0220233.

See Das et al. '746, col. 261, compound 559.

See Hynes et al. '233, p.22, table 1, compound 33.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 6-10, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Das et al., US 6,596,746.

Determination of the scope and content of the prior art (MPEP §2141.01)

Das et al. '746 generically disclosed the instant claimed compounds with an exemplified species anticipating the base claims (see rejection supra)

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the prior art species and the instant claims is that more examples anticipating the base structure of the claims were disclosed. However, a clear and comprehensive description of the alternative Markush choices for the prior art compounds have been found through the whole article with ample exemplifications of the variations of choices in substituents, variation in position of the substituents etc. see whole references of Das.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

. One having ordinary skill guided by the anticipatory example together with the multiple examples and clear comprehensive teaching with ample of other examples would expect

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the instant claims being variation in substituents and position of substitution (see the many examples including benzimidazolyl compounds 566-567) from the prior art compounds which falls within the generic teaching of the prior art, to have similar activity as the anticipatory compound. In absence of unexpected results, there is nothing unobvious in choosing some among many. In re Lemin 141 USPQ 814.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 6-10, 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hynes et al. US 2004/0220233.

Determination of the scope and content of the prior art (MPEP §2141.01)

Hynes et al. '233 generically disclosed the instant claimed compounds with an exemplified species anticipating the base claims (see rejection supra)

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the prior art species and the instant claims is that more examples anticipating the base structure of the claims were disclosed. However, a clear and comprehensive description of the alternative Markush choices for the prior art compounds have been found through the whole article with ample exemplifications of the variations of choices in substituents, variation in position of the substituents etc. see whole references of Hynes et al.

Finding of prima facie obviousness—rational and motivation (MPEP §2142-2143)

One having ordinary skill guided by the anticipatory example together with the multiple examples and clear comprehensive teaching with ample of other examples would expect the instant claims being variation in substituents and position of substituents from the prior art compounds which falls within the generic teaching of the prior art, to have similar activity as the

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anticipatory compound. In absence of unexpected results, there is nothing unobvious in choosing some among many. In re Lemin 141 USPQ 814.

5. Applicants attention is drawn to US 2005/0130970 which was filed within one year of the instant provisional. The publication evidenced that the claims of the publication includes the anticipatory compound against the instant claims when Y is CH₂ (see page 50, compound 43). The instant claims encompassed compound 43 wherein R₄, R₈ or R₉ is alkoxy. However, no species or examples were found in the specification to have alkoxy substitution. In view of that the species always anticipates the genus while generic disclosure lacks antecedent basis for species, the issue under 102(f) or (g) may have to be raised.

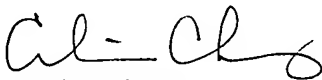
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
May 30, 2006


Celia Chang
Primary Examiner
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